

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 1 and 23 have been amended. Support for the amendments may be found throughout the specification, for example at original claim 3 and at page 7, lines 2-5 of the specification. No new matter has been added. Claim 3 has been cancelled and its subject matter has been incorporated into claims 1 and 23. Upon entry of the above amendments, claims 1-2 and 4-23, as amended, will be pending.

Claims 1-2, 5 and 20-21 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 6,288,012 to Li ("Li") in view of the Evidence provided by Solozhenko, *Properties of Group III Nitrides*, J.H. Edgar ed., Section 2.1, page 43 ("Solozhenko"). Without agreeing with the Examiner's characterization of the relevant case law regarding anticipation,¹ the amendment to the claims is believed to address this rejection. Specifically, Li does not teach an oil dispersion of hexagonal boron nitride having a particle size distribution wherein 90% or greater of the particles are less than about 0.5 microns. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 1-2, 4, 6, 9 and 20-23 have been rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 4,715,972 to Pacholke in view of Dickey, *Kirk-Othmer Encyclopedia of Chemical Technology*, Vol. 15, in *Lubrication and Lubricants*, p. 33 ("Dickey") and U.S. Patent 5,652,201 to Papay. Claims 7-8 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Pacholke in view of Dickey, Papay and further in view of U.S. Patent 5,780,399 to Ishikawa ("Ishikawa"). Claims 10-13 and 15-19 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Pacholke in view of Dickey, Papay and further in view of U.S. Patent 3,313,727 to Peeler ("Peeler"). Claim 14 has been rejected under 35 U.S.C. § 103(a) as unpatentable over Pacholke in view of Dickey, Papay, Peeler and further in view of U.S. Patent 5,641,730 to Brown ("Brown"). The amendments to the claims are believed to address this rejection. Specifically, none of the cited references alone or in combination teach or suggest an oil dispersion of hexagonal boron nitride having a particle size distribution wherein 90% or greater of the particles are less than about 0.5 microns.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as unpatentable in view over Pacholke in view of Dickey, Papay and further in view of U.S. Patent 4,094,799 to De Vries ("De Vries"). Respectfully, the Examiner has failed to establish a *prima facie* case of obviousness because the cited references do not teach or suggest each and every limitation of claim 3. Specifically, none of the cited references alone or in combination teach or suggest an oil dispersion of hexagonal boron nitride having a particle size distribution wherein 90% or

¹ Respectfully, the Examiner's characterization of the relevant case law is flawed. Specifically, the Examiner has failed to consider that prior to selecting among the various boron nitride morphologies, it would be necessary to select the genus of boron nitride from the vastly larger genus of listed solid lubricants identified within Li given no pattern of preference suggesting its use. Accordingly, at least 2 selections are required to get to hexagonal boron nitride, neither of which is suggested or preferred.

greater of the particles are less than about 0.5 microns. The Examiner attempts to rely on De Vries for this limitation, but in addition to failing to teach or suggest anything about *hexagonal* boron nitride, De Vries fails to teach or suggest anything about a particle size distribution, let alone the claimed particle size distribution. De Vries only mentions that its solid particles are most preferably in the range of from 1 millimicron to about 1 micron, not that 90% or greater of the particles are less than about 0.5 microns. For at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection with respect to amended claims 1 and 23.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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